

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK RAPPAPORT

Appeal No. 97-0767
Application No. 08/383,996¹

ON BRIEF

Before MEISTER, ABRAMS, and CRAWFORD, Administrative Patent Judges.

MEISTER, Administrative Patent Judge.

DECISION ON APPEAL

Mark Rappaport (the appellant) appeals from claims 1-3 and 8-10. Claims 4-7, the only other claims present in the application, have been indicated as being allowable subject to the requirement that they be rewritten to include all the subject matter of the claims from which they depend. We affirm.

¹ Application for patent filed February 6, 1995.

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The appellant's invention pertains to an air-pressurized baseball bat. Independent claim 10 is further illustrative of the appealed subject matter and reads as follows:

10. An air-pressurized baseball bat useable by children to strike an oncoming ball so that it is driven a relatively great distance, said bat comprising:

A. a hollow striker section defined by a shell of thin, flexible synthetic plastic film material impermeable to air having a shape and size similar to that of a striker section of a conventional baseball bat;

B. a handle section joined to the striker section;
and

C. a valve mounted on the bat through which air is injected into the striker section to produce a compressed air charge therein well above atmospheric pressure whereby the charge of compressed air acts as a pneumatic spring and said shell acts as a taut spring-loaded trampoline sheet causing a ball impinging thereon to rebound and be driven a relatively long distance.

The references relied on by the examiner are:

Tanigawa (Japanese application) ²	52-37126	Mar. 22, 1977
Fox (UK application)	2 146 538	Apr. 24, 1985

² Translation attached.

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Claims 1-3 and 8-10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Fox in view of Tanigawa. The examiner considers that it would have been obvious to provide the bat of Fox with a valve for pressurizing the interior thereof in view of the teachings of Tanigawa.

Rather than reiterate the arguments of the appellant and examiner in support of their respective positions, reference is made to the brief, reply brief, answer and supplemental answer for the full exposition thereof.³

OPINION

We have carefully reviewed the appellant's invention as described in the specification, the appealed claims, the prior art applied by the examiner and the respective positions advanced by the appellant in the brief and supplemental brief and by the examiner in the answer and supplemental answer. This review leads us to conclude that the prior art relied on by the examiner establishes the obviousness of the appealed subject matter within the meaning of 35 U.S.C. § 103.

³ A supplemental reply brief filed on September 30, 1996 (Paper No. 14) has not been entered by the examiner (see Paper Nos. 15 and 18).

The main thrust of the appellant's position is that

Fox fails to disclose an empty Coca Cola bottle (envelope) that is "hermetically sealed" so that it can sustain a charge of compressed air.

There is a vast difference between a sealed bat envelope that is not air tight and one that is, for only the latter can hold a charge of compressed air "well above atmospheric pressure." Moreover, Fox shows no means to inject compressed air into his empty Coca Cola bottle and in no way contemplates pressurizing the bottle.

* * *

To justify his Section 103 rejection, the Examiner says it would be obvious to the skilled artisan to fully seal Fox's Coca Cola bottle envelope and to add a valve thereto in view of Tanigawa who shows a hollow bat (metal, wood or plastic) which is pressurized by gas admitted through a valve in the handle of the bat.

In Tanigawa the entire, relatively rigid bat is pressurized, not just a thin skinned plastic film bottle section in the manner of the present invention which in the absence of internal pressure would collapse. Nothing in this reference suggests to one skilled in the art a modification of Fox to recreate the claimed invention by heretically sealing the plastic bottle and adding a valve thereto. [Reply brief, pages 1 and 2.]

We are unpersuaded by the appellant's arguments. While there must be some teaching, reason, suggestion, or motivation to combine existing elements to produce the claimed device (**see, e.g., ACS-Hospital Systems, Inc. v. Montefiore Hospital**, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)), it not necessary that the cited references or prior art specifically suggest making the combination (**B.F. Goodrich Co. V. Aircraft Braking Systems Corp.**, 72 F.3d 1577, 1583, 37 USPQ2d 1314, 1319 (Fed. Cir. 1996) and **In re Nilssen**, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988)). Rather the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. **In re Young**, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and **In re Keller**, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

Here, Fox discloses a light-weight baseball bat useable by children (page 1, line 7) to strike a ball including a striker section 12 defined by a shell of thin, flexible synthetic plastic film (i.e., a conventional two liter plastic beverage bottle as disclosed on page 1, lines 50, 107, 108) which is threaded into a handle section 10 (see Fig. 2). The artisan would reasonably infer that the bottle forming the striker portion 12 of Fox was

filled with air (albeit non-pressurized). Tanigawa discloses a bat which may be made of plastic (translation, page 2, line 3) having a hollow section that may be "provided only at the internal area corresponding to the ball-hitting section" (translation, page 2, lines 17 and 18), which hollow section may be filled with pressurized air for the purpose of preventing dents, cracks, etc. from occurring when a ball is hit with the bat (translation, page 1, lines 18-25). Tanigawa further teaches a one-way feed valve 7 which, although illustrated in Fig. 2 as being in conjunction with a safety valve 5, may be separate therefrom (translation, page 5, lines 17-20). Although Tanigawa illustrates the valve as being placed within a container 4 which in turn is placed in a recess 3 in the end of the handle of the bat, it is stated therein that it "is possible to configure the present invention without the container (4) by embedding the other components of the valve mechanism in the grip of the bat's main body (1)" (translation, page 7, lines 21-24). In our view, one of ordinary skill in this art would have found it obvious to seal, and provide a valve for, the striker section 12 of the bat of Fox in order that it can be pressurized so as to achieve Tanigawa's expressly stated advantage of preventing cracks.

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As to the appellant's contention that Fox fails to expressly state that his envelope or bottle is hermetically sealed and lacks a means to inject air therein, we observe that nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. **See In re Merck & Co. Inc.**, 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986). Here, the rejection is based on the **combined** teachings of Fox and Tanigawa, and it is Tanigawa who clearly teaches that the hollow striker section should be sealed and provided with a valve to inject air under pressure therein. In this regard, it should be noted that all of the features of the secondary reference need not be bodily incorporated into the primary reference (**see In re Keller**, 642 F.2d at 425, 208 USPQ at 881) and the artisan is not compelled to blindly follow the teaching of one prior art reference over the other without the exercise of independent judgment (**Lear Siegler, Inc. v. Aeroquip Corp.**, 733 F.2d 881, 889, 221 USPQ 1025, 1032 (Fed. Cir. 1984)).

It is also the appellant's contention that the relied on prior art does not teach a bat having trampoline-like characteristics. We must point out, however, that all the utilities or benefits of the claimed invention need not be

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explicitly disclosed by the prior art references to render the claim unpatentable under section 103 (**see *In re Dillon***, 919 F.2d 688, 692, 696, 16 USPQ2d 1897, 1901, 1904 (Fed. Cir. 1990) (in banc), **cert. denied**, 500 U.S. 904 (1991)) and "[t]he fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise have been obvious" (***Ex parte Obiaya***, 227 USPQ 58 (BPAI 1985), **aff'd.mem.**, 795 F.2d 1017 (Fed. Cir. 1986)). Similarly, the mere recognition of latent properties in an otherwise obvious product in the prior art does not render such a product unobvious. **See *In re Prindle***, 297 F.2d 251, 254, 132 USPQ 282, 283-84 (CCPA 1962).

With respect to claim 3 the appellant notes that Fox does not teach a valve formed by a rubber plug that is penetrable by a hypodermic needle. While this is true, the appellant has not disputed the examiner's position that such valves are common and well known and that it would have been obvious to utilize such a valve in the bat of Fox, as modified by Tanigawa.

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As to claim 8 the appellant also argues that Fox does not teach that his shell is formed of polycarbonate material. However, page 8 of the appellant's specification merely states that the shell may be formed of a synthetic plastic material "**such as** polycarbonate or PET that is impermeable to air" (emphasis ours), leading us to conclude that the selection of the particular plastic material is an obvious matter engineering design choice. After all, artisans must be presumed to know something about the art apart from what the references disclose (**see In re Jacoby**, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962)) and the conclusion of obviousness may be made from "common knowledge and common sense" of the person of ordinary skill in the art (**see In re Bozek**, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)).

As to claim 9 the appellant argues that Fox does not teach a handle section that "is hollow and molded of high-strength synthetic plastic" (brief, page 4). We observe, however, that

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Fox in lines 125 and 126 of page 1 states that the handle 10 is an "elongate tubular plastics member" and this handle is clearly depicted in Figs. 3 and 4 to be hollow. Noting that the appellant has provided no particular definition of "high-strength," we are of the opinion that a handle made of a plastic material which had sufficient strength to be used in the manner depicted in Fig. 1 of Fox, can be considered to be formed of a "high-strength" plastic as broadly claimed. In any event, the artisan as a matter of common sense (***see In re Bozek, supra***) would have made the handle of a "high-strength" plastic material so as to enable the bat to function in the manner intended.

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In view of the foregoing we will sustain the examiner's rejection of the appealed claims under 35 U.S.C. § 103 based on the combined teachings of Fox and Tanigawa.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

JAMES M. MEISTER)	
Administrative Patent Judge)	
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)	
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)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
MURRIEL E. CRAWFORD)	
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APJ MEISTER

APJ ABRAMS

APJ CRAWFORD

DECISION: **AFFIRMED**

Typed By: Jenine Gillis

DRAFT TYPED: 25 Nov 98

FINAL TYPED: